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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>  <b>Mail Stop: AMENDMENT</b>  Express Mail Receipt No.  Total Number of Pages in This Submission	Application / Conf. No.	10/742,300 / 5676
	Filing Date	December 18, 2003
	First Named Inventor	Xiao-Jie Yuan
	Examiner Name	ERnest F. Karlsten
	Art Unit	2829
	Patent No.	
	Attorney Docket Number	X-1447 US

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> Preliminary Amendment <input type="checkbox"/> After Final <input type="checkbox"/> Affidavit(s)/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Change Status to LARGE ENTITY <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Substitute PTO-1449(s) IDS by Applicant (PTO/SB/08A) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (with Recordation Cover Sheet) <input type="checkbox"/> Declaration / Oath <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition -  <input type="checkbox"/> To Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund	<input type="checkbox"/> After Allowance Communication to  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Return Receipt Postcard <input type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; height: 40px; width: 100%;"></div>
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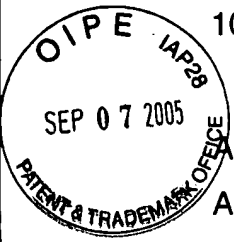
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X-1447 US  
10/742,300

PATENT  
Conf. No.: 5676



IN THE UNITED STATES PATENT OFFICE

Applicants: Xiao-Jie Yuan et al.  
Assignee: Xilinx, Inc.  
Title: "Characterizing Circuit Performance by Separating Device and Interconnect Impact on Signal Delay"

Serial No.:	10/742,300	Filed:	12-18-03
Examiner:	Ernest F. Karlsen	Art Unit:	2829
Docket No.:	X-1447 US	Conf. No.:	5676

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Mail Stop AMENDMENT  
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RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

Claims 1-22 are pending in the present invention. The Examiner has restricted the claims to four groups: I. Claims 1-8, II. Claims 9-25, III. Claims 16-20 and IV. Claims 21-22.

In response to the Restriction Requirement mailed from the Patent Office on August 4, 2005, Applicants traverse the restriction and requests the Examiner withdraw the restriction. However, in order to comply with 37 CFR 1.143, Applicants provisionally elect with traverse, group III, claims 16-20 and withdraws claims 1-15 and 21-22. Applicants reserve the right to prosecute Group I, II, and IV (Claims 1-15 and 21-22) in subsequent divisional applications.

For groups I and II: assuming arguendo, that the Examiner has shown the inventions are distinct and independent (35 U.S.C. 121), the Examiner must show, in addition, there is a serious burden on the Examiner, if the claims are not restricted.

MPEP 803 states:

an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent... or distinct .... If the search and examination of an entire application can be made without serious burden,

the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

.....  
For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.

As shown in the Office action, both groups I and II have the same class 324 and subclass 765, thus the Examiner has admitted there is no serious burden. For at least this reason alone, the Applicants request the Examiner withdraw the restriction requirement on groups I and II.

For groups II and IV (product claims) and Groups I and II (process claims) the Examiner has restricted them based on MPEP 806.05(h), which states:

A product and a process of using the product can be shown to be distinct inventions if .... the product as claimed can be used in a materially different process.

The burden is on the examiner to provide an example, but the example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.

The Examiner stated "in the instant case the apparatus can be used to practice a plurality of methods as disclosed." The Applicants request an example, by product, of the materially different process that product can be used in, so that the Applicants can provide an argument, if necessary, concerning the alternative. Otherwise the Examiner has not met his burden and the Applicants request withdrawal of the restriction requirement for groups III and IV in a first set from groups I and II in a second set.

For the groups I and II the Examiner has restricted the groups based on MPEP 806.05(c), which states:

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the sub-combination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

First, The Examiner has admitted the same class and subclass for groups I and II and as such has not shown a requirement for restriction. For this reason alone Applicants request withdrawal of the restriction requirement. Second the Examiner has stated the above factors as conclusions rather than giving reasons for the conclusions as required by MPEP 816, which states:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to combination and a sub-combination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part.

Each other relationship of claimed invention should be similarly treated and the reasons for the conclusions of distinctness of invention as claimed set forth.

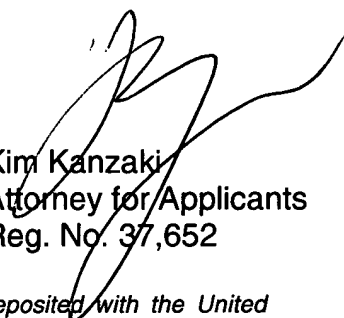
Applicants request the Examiners reasons that the combination and subcombination inventions are distinct, not just the mere conclusion; otherwise the Applicants request withdrawal of this restriction.

The Applicants request clarification of the statement "each of inventions III and IV do not require the remaining of inventions III and IV". Applicants do not know what this means.

Thus Applicants request withdrawal of the restriction requirement and allowance of the claims.

A listing of the claims in the present application is appended hereto.

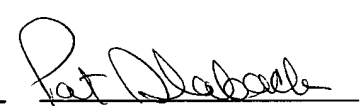
Respectfully submitted,



Kim Kanzaki  
Attorney for Applicants  
Reg. No. 37,652

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\_\_\_\_\_  
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